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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN F. JERDING, SHASHI GOEL,
ROBERT O. BANKER, and VALERIE G. GUTKNECHT

Appeal 2009-001407
Application 09/590,488
Technology Center 2400

Decided: December 22, 2009

Before JOHN C. MARTIN, MARC S. HOFF, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from the Examiner's rejection of claims 74-95. Claims 1-73 have been cancelled (App. Br. 2).[1] We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We reverse.

Appellants' invention relates to a television settop box, or digital home communication terminal (DHCT), with various functionalities associated with video-on-demand (VOD) services. More specifically, Appellants claim a method that "includes several actions ('determining,' 'providing,' 'establishing') that are 'responsive to' certain conditions" (App. Br. 5), including "responsive to a [DHCT] experiencing a reboot condition" (*e.g.*, claim 74). Appellants also claim a DHCT comprising memory and program code stored in the memory that enables the DHCT to perform several actions "when the DHCT experiences a reboot condition" (*e.g.*, claim 89).

Independent claims 74 and 89 are illustrative, reading as follows:

74. A method comprising:

responsive to a digital home communication terminal (DHCT) experiencing a reboot condition, determining if at least one video-on-demand (VOD) rental has been purchased and has not expired;

responsive to determining that at least one VOD rental has been purchased and has not expired, determining whether a previously established VOD session for a first VOD presentation is still active;

responsive to determining that the previously established VOD session for the first VOD presentation is still active, providing a VOD current rental screen that includes a selectable option to view the first VOD presentation, the VOD current rental screen having a VOD title of the first

[1] Throughout this opinion we refer to (1) the Appeal Brief ("App. Br.") filed July 30, 2007; (2) the Examiner's Answer ("Ans.") mailed Jan. 11, 2008; and (3) the Reply Brief ("Reply Br.") filed Mar. 11, 2008.

VOD presentation, information on the length of time remaining on the VOD title, and information on the rental time duration remaining for viewing the VOD title;

responsive to determining that the at least one VOD rental has been purchased and has not expired and responsive to determining that the previously established VOD session for the first VOD presentation is no longer active, establishing another active VOD session for the first VOD presentation and providing the VOD current rental screen; and

responsive to determining that at least one VOD rental has not been purchased or that previously-purchased VOD rentals have expired, providing a list of selectable VOD titles.

89. A digital home communication terminal (DHCT) comprising:

memory; and

program code stored in said memory, wherein, when the DHCT experiences a reboot condition, the program code is configured to enable the DHCT to:

determine if at least one video-on-demand (VOD) rental has been purchased and has not expired,

responsive to determining that at least one VOD rental has been purchased and has not expired, determine whether a previously established VOD session for a first VOD presentation is still active,

responsive to determining that the previously established VOD session for the first VOD presentation is still active, provide a VOD current rental screen that includes a selectable option to view the first VOD presentation, the VOD current rental screen having a VOD title of the first VOD presentation, information on the length of time remaining on the VOD title, and information on the rental time duration remaining for viewing the VOD title,

responsive to determining that the at least one VOD rental has been purchased and has not expired and responsive to determining that the previously established VOD session for the first VOD presentation is no longer active, establish another active VOD session for the first VOD presentation and provide the VOD current rental screen, and

responsive to determining that at least one VOD rental has not been purchased or that previously-purchased VOD rentals have expired, provide a list of selectable VOD titles.

The Examiner relies on the following prior art references to show unpatentability:

Metz	US 5,666,293	Sep. 9, 1997
Dunn	US 5,721,829	Feb. 24, 1998
Casement	US 5,969,748	Oct. 19, 1999 (filed May 29, 1996)
Goode	US 6,166,730	Dec. 26, 2000 (filed May 28, 1999)
Swix	US 6,609,253 B1	Aug. 19, 2003 (filed Dec. 30, 1999)

Claims 74-79 and 89-92 stand rejected under 35 U.S.C. § 103(a) as obvious over Metz in view of Goode, Dunn, and Swix.

Claims 80-88 and 93-95 stand rejected under 35 U.S.C. § 103(a) as obvious over Metz in view of Goode, Dunn, Swix, and Casement.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ARGUMENTS AND ISSUE

The Examiner finds that the combination of Goode, Dunn, and Swix teaches a DHCT having all of the functionality recited in independent claims 74 and 89 except for the claim language relating to the reboot condition (Ans. 3-7). The Examiner finds that Metz discloses a method implemented via a DHCT wherein, responsive to experiencing a reboot condition, the

DHCT is operable to provide and support VOD services (Ans. 3-4). The Examiner also sets forth motivation for combining the references (Ans. 5-7).

In applying the references against the claims, the Examiner interprets the claim term "responsive to" more broadly than Appellants believe to be reasonable. Specifically, the Examiner states that "responsive to" is being interpreted "merely as an ordered operation of process steps wherein certain steps are performed indirectly following or in return to the condition having occurred" (Ans. 13). The Examiner further clarifies his position: the open ended nature of the claims does not require that the "determining" step be performed immediately after rebooting (Ans. 15). But rather, "[a]ny further operation of a [DHCT] terminal that became inoperative is necessarily 'responsive to' the terminal experiencing a reboot condition" (*id.*). That is, "the combination of references (i.e., a Metz rebooting terminal that continues to offer VOC functionality after rebooting) having been modified to provide a particularly known VOD function after having been reboot[ed] (i.e. the VOD functionality of Goode) teaches the claimed limitation" (*id.*). We understand, then, the Examiner to be interpreting the claim language "[an act] responsive to [a condition]" (*see e.g.*, claims 74 and 89) as being synonymous with an act occurring *subsequent to* a condition, or an act that is *enabled by* a condition.

Appellants agree with the Examiner that their Specification does not set forth any special definition for the term "responsive to" (Reply Br. 2). Appellants also agree with the Examiner that "'the claims do not require the degree to which the actions are in fact 'responsive to' the conditions (i.e. directly responsive to versus indirectly responsive to)'" (*id.*). Appellants assert, though, that the ordinary meaning of the term "responsive to" is still

narrower than the Examiner's unreasonably broad interpretation. That is, "a step 'responsive to' another must not only occur later in time, but must also be performed as a direct or indirect result of the first step being performed" (Reply Br. 2-3). Appellants maintain that the rejection is improper because the Examiner's rejection "ignores this result aspect of the phrase 'responsive to' and interprets 'responsive to' as requiring only that one action follow another" (Reply Br. 3).

The issue before us, then, is: Have Appellants shown that the Examiner erred in interpreting the term "responsive to" broadly as requiring only that an action follow a preceding event, without further requiring that the action be a necessary result of the preceding event?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974). If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

FINDING OF FACT

1. The term "response" is defined as "making answer or reply, esp. responding or reacting readily to influences, appeals, efforts, etc." *Webster's Encyclopedic Unabridged Dictionary of the English Language*, 1222 (1989).

ANALYSIS

"Before considering the rejections . . ., we must first [determine the scope of] the claims . . . ." *In re Geerdes*, 491 F.2d 1260, 1262 (CCPA 1974). We therefore first determine the meaning of the claim term "responsive to." Webster's general purpose dictionary defines "response" as "making answer or reply, esp. responding or reacting readily to influences, appeals, efforts, etc." (FF 1). Based upon this definition, we are persuaded by Appellants' arguments. The broadest reasonable interpretation of the claim term "responsive to" requires that a step or action necessarily result from a preceding action or event. Contrary to the Examiner's position, it is not sufficient that an act merely follow or occur subsequent to another action or event.

Claim 74 requires that the action, "determining if at least one [VOD] rental has been purchased and has not expired," be responsive to the preceding event, "a [DHCT] experiencing a reboot condition." Following the adopted interpretation, then, the action of "determining" must necessarily, and at least indirectly, result from the DHCT experiencing a reboot condition. That is, the claimed determining step may either be (1) a direct result of the reboot, or alternatively be (2) any, or even the last, one of many actions carried out by a Rube Goldberg-style process as an indirect

result of the reboot. Regardless, claim 74 requires that the determining step necessarily results from the DHCT reboot.

The Examiner bases the rejection of claim 74 solely on the broader, alternative interpretation of "responsive to," and does not allege that the cited prior art would render claim 74 obvious under the narrower interpretation that we adopt today (*see* Ans. 3-21). For the foregoing reasons, then, Appellants have persuaded us of error in the Examiner's obviousness rejection of independent claim 74. Accordingly, we will not sustain the Examiner's rejection of that claim or of claims 75-79 which depend from claim 74.

Independent claim 89 differs from claim 74 in that claim 89 states, "*when* the DHCT experiences a reboot condition, the program code is *configured to enable* the DHCT to: determine if at least one [VOD] rental has been purchased and has not expired." As such, this language is broader than the first limitation of claim 74, and more consistent with the Examiner's interpretation. In claim 89, the determining step is merely *enabled when* the DHCT experiences a reboot condition, not *responsive to* the reboot condition.

However, claim 89 next recites, "*responsive to* determining that at least one VOD rental has been purchased and has not expired, determine whether a previously established VOD session for a first VOD presentation is still active." That is, claim 89 also requires that the second determining step necessarily result from, or occur after, the preceding determining step. Appellants also argue that Goode "does not further enable a DHCT to perform any action 'responsive' to [the first determination that at least one VOD rental has been purchased and has not expired]" (Reply Br. 9).

The Examiner does not allege that Goode teaches any determinations "responsive to," or necessarily being made as a result of, this first determination (*see* Ans. 3-21). Rather, the Examiner states that the "determining whether a previously established VOD session for a first VOD presentation is still active" is the inherent or necessary result of a user attempting to restart a presentation (Ans. 17). For the foregoing reasons, then, Appellants have persuaded us of error in the Examiner's obviousness rejection of independent claim 89. Accordingly, we will not sustain the Examiner's rejection of that claim or of claims 90-92 which depend from claim 89.

With respect to the remaining rejection of dependent claims 80-88 and 93-95, Casement does not cure the deficiency of the obviousness rejection explained above. For the same reasons then, we likewise do not sustain the rejection of claims 80-88 and 93-95.

CONCLUSION

Appellants have shown that the Examiner erred in interpreting the term "responsive to" broadly, as requiring only that an action follow a preceding event, without further requiring that that the action be a necessary result of the preceding event. Accordingly, Appellants have shown that the Examiner erred in rejecting claims 74-95 under 35 U.S.C. § 103.

DECISION

We do not sustain the Examiner's rejections with respect to all pending claims on appeal. Therefore, the Examiner's decision rejecting claims 74-95 is reversed.

REVERSED

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